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10/725,770

12/02/2003

Robert M. Solberg

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08/25/2004

LADAS & PARRY

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EXAMINER

KRAWCZEWICZ MYERS, LOUANNE C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/725,770

Applicant(s)

SOLBERG, ROBERT M.

Examiner

Louanne C Krawczewicz Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on application filed 12/2/03 and 3/26/04. *abstract filed*
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/9/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Objection to the Drawing**

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations filed December 2, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)). Also, the drawings should be submitted in duplicate.

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at:

<http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112 first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. Throughout the entire specification (pages 1-3) should be double-spaced instead of single-spaced.
- B. The disclosure is objected to under 37 CFR 1.121 (e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c) (4)(5) and 37 CFR 1.163(d). This information should be set forth before the "BACKGROUND OF THE INVENTION" section as set forth in 37 CFR 1.163(c).
- C. Page 1, line 3, Applicant sets forth a Genus but has not set forth a species designation for the instant plant. Applicant should set forth in the specification the species designation for the instant plant (MPEP 1605).

D. Page 1, lines 4-5, Applicant states the instant plant was discovered as a mutation of 'Paul's Glory'. However, Applicant has not stated whether the instant plant was a whole plant, branch, or other mutation. Also, Applicant has not stated whether the mutation was naturally occurring or induced. Applicant should set forth in the specification the type of mutation and whether the mutation was naturally occurring or induced. If induced, Applicant should set forth in the specification the methodology used to derive the instant plant. The origin of the plant should be unambiguously set forth in the specification.

E. Page 1, line 18 and in the Abstract, lines 3 and 4, Applicant states that the instant plant has leaves of "moderate substance". It is vague and unclear as to what Applicant intends "substance" to mean. Correction to the specification and/or clarification is necessary.

F. Page 1, line 35, Applicant states "described". Rather than stating described, it appears the term --describe-- would be more grammatically correct to use in this instance.

G. Page 1, line 35, Applicant states "more accurately". The color designations set forth in the specification must accurately depict the actual colors of the instant plant (MPEP 1605). Applicant should verify the color designations set forth and delete "more" if the color designations are accurate. If the color designations are

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not accurate, Applicant should set forth in the specification accurate color designations and delete "more".

- H. Page 2, line 8, Applicant states "Horticulture". Applicant should delete Horticulture and insert --Horticultural-- as Horticultural is the proper term to use in this society's name.
- I. Page 2, lines 7-12, Applicant should set forth in the specification whether the instant plant was grown indoors or outdoors and container size, if grown in a container.
- J. Page 2, line 20, Applicant states in the specification "moist shade". This recitation is not understood as it is unclear what Applicant intends moist shade to mean. Correction to the specification and/or clarification is necessary.
- K. Page 2, lines 29 and 30, Applicant sets forth in the specification that the leaf texture is "moderate to heavy substance". It is vague and unclear as to what Applicant intends "substance" to mean with reference to leaf texture. Clarification to the specification is necessary.
- L. Page 2, lines 32-40, Applicant sets forth in the specification leaf colors for early season foliage, mid-season foliage and late season foliage of the instant plant.

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However, Applicant has not stated whether the color set forth is for the upper, lower or both surfaces. Applicant should set forth in the specification a color designation(s) for the instant plant's early, mid-season and late-season foliage for both surfaces with reference to the employed color chart.

M. Page 2, line 33, Applicant states "Orange Yellow 12B". When compared with the RHS dictionary of Color, 12B is in the "Yellow group". Correction to the specification and/or clarification is necessary.

N. Page 2, line 33, Applicant states "Blue-green 137A". When compared with the RHS dictionary of Color, 137A is in the "Green group". Correction to the specification and/or clarification is necessary.

O. Page 2, line 34 and 37, Applicant states "green 144A". When compared with the RHS dictionary of color, 144A is in the "Yellow-Green" group. Correction to the specification and/or clarification is necessary.

P. Page 2, line 36, Applicant states "Blue-green 135A". When compared with the RHS Dictionary of Color, 135 A is in the "Green" group. Correction to the specification and/or clarification is necessary.



- Q. Page 2, lines 38 and 39, Applicant states "Near white 11C". When compared with the RHS dictionary of Color, 11C is in the "Yellow" group. Correction to the specification and/or clarification is necessary.
- R. Page 2, line 39, Applicant states " Blue-green 136A". When compared with the RHS dictionary of Color, 136A is in the "Green group". Correction to the specification and/or clarification is necessary.
- S. Page 2, line 40, Applicant states "yellow 153B". When compared with the RHS dictionary of Color, 153B is in the "Yellow-Green" group. Correction to the specification and/or clarification is necessary.
- T. Page 3, lines 2 and 3, Applicant states "yellow color, 144D". When compared with the RHS dictionary of Color, 144D is in the "Yellow-Green" group. Correction to the specification and/or clarification is necessary.
- U. Page 3, line 3, Applicant states "blue-green, 135A". When compared with the RHS dictionary of Color, 135A is in the "Green" group. Correction to the specification and/or clarification is necessary.

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V. Page 3, lines 4 and 5, Applicant states "yellow color 145B". When compared with the RHS dictionary of Color, 145 B is in the "Yellow-Green" group.

Correction to the specification and/or clarification is necessary.

W. Page 3, line 5 and 6, Applicant states "blue-green 136A to 137A". When compared with the RHS dictionary of Color, 136A and 137A are in the "Green" group. Correction to the specification and/or clarification is necessary.

X. Page 3, lines 10-12, Applicant should set forth in the specification additional information relative to the instant plant's flowers including the number of flowering stems per plant:

Y. Applicant should set forth in the specification information relative to the instant plant's flower buds including diameter, length, shape, and color with reference to the observed color chart.

Z. Page 3, line 18, Applicant states in the specification that the instant plant's perianth is arranged with "Three interior and tree exterior tepals". It would appear that there is a spelling error and that "tree" should instead be --three--, if correct.

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AA. Page 3, lines 18-20, Applicant has set forth color designations for the tepals, however, it is unclear if these color designations refer to the instant plant's tepal coloration for upper surface, lower surface or both surfaces. Applicant should set forth in the specification color designations for the upper and lower tepal surfaces with reference to the employed color chart.

BB. Page 3, lines 18-20, Applicant should set forth in the specification additional information relative to the instant plant's tepals including typical and observed tepal shape, texture and apex and margin descriptors.

CC. Page 3, lines 21-23, Applicant should set forth in the specification additional information relative to the instant plant's floral bracts including the number of bracts per flower.

DD. Page 3, line 23, Applicant states "blue-green margin, 137A". When compared with the RHS dictionary of Color, 137A is in the "Green" group. Correction to the specification and/or clarification is necessary.

EE. Page 3, line 27, Applicant states "Blue-green 142B". When compared with the RHS dictionary of Color, 142B is in the "Green" group. Correction to the specification and/or clarification is necessary.

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FF. Page 3, line 29, Applicant states "Near White 157D". When compared with the RHS dictionary of Color, 157D is in the "Green-White" group. Correction to the specification and/or clarification is necessary.

GG. Page 3, line 31, Applicant states "Yellow 17B". When compared with the RHS dictionary of Color, 17B is in the "Yellow-Orange" group. Correction to the specification and/or clarification is necessary.

HH. Page 3, line 38, Applicant states "Blue-green, 146C". When compared with the RHS dictionary of Color, 146C is in the "Yellow-Green" group. Correction to the specification and/or clarification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> Paragraphs

**Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.**

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance.

Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicant should note the new amendment format. (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louanne C. Krawczewicz Myers whose telephone number is (571) 272-0979. The examiner can normally be reached on Monday and Thursday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone numbers for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

LKM

*LKM*

KENT BELL  
PRIMARY EXAMINER

*Kent Bell*